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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 76682440 |
| Applicant | Jenkins, Jason |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jason Jenkins
Serial No.: 76/682,440
Filing Date: October 1, 2007
Mark: OUCH! MOUNTAIN & Design
Examiner: Michael Litzau Law Office 104

APPLICANT'S APPEAL BRIEF

Applicant appeals the examining attorney's refusal to register Applicant's OUCH! MOUNTAIN & Design mark under Section 2(d) based on the assertion that it is confusingly similar to the mark in U.S. Registration Nos. 2,119,347.

Facts and Background

Applicant filed an application on October 1, 2007, requesting registration of its OUCH! MOUNTAIN & Design mark for clothing and apparel items, namely, shirts, sweatshirts, hats, socks and jackets in International Class 25, based on applicant's bona fide intent to use the mark in commerce for the goods. Applicant's mark is shown below for purposes of convenience.



On January 16, 2008, the Examining Attorney issued an office action refusing to register Applicant's mark under Section 2(d), alleging that use of the mark would be likely to cause

confusion, mistake, or deception with respect to the mark OUCH of U.S. Trademark Registration No. 3,082,697 registered for swimwear in International Class 25, and the mark OUCH WEAR SO GOOD IT HURTS (Stylized) of U.S. Trademark Registration No. 2,119,347 registered for t-shirts, jackets, and hats, in International Class 25. These registrations are owned by different parties. The registrations have subsisted on the Principal Register, side-by-side for approximately three years.

In Applicant's July 16, 2008, response to the office action, Applicant amended its goods to specify that the clothing was intended for outdoorsmen and presented arguments in response to the 2(d) rejection. Thereafter, on August 11, 2008, the Examining Attorney issued a final office action wherein he withdrew the rejection based on the '697 registration but continued the rejection based on the '347 registration.

Argument

Applicant respectfully submits that its mark can readily be distinguished from the mark of the '347 registration by reasonably prudent consumers of the respective goods. The common subject matter is the terminology "ouch," which is shown to also be in common with several other registered marks and marks of allowed applications for other clothing and apparel items. The elements "!" and "Mountain," the stylized lettering font, and the prominent mountain/backpacker design are more than sufficient to distinguish Applicant's mark from the cited mark. Considered in their entireties, the marks are not confusingly similar.

A. The Element “Ouch” Common to the Marks is Weak and Dilute in Relation to the Goods, and is not Likely to Cause Confusion as to the Source of the Goods.

The terminology “Ouch” in Applicant’s mark and the cited mark is weak in relation to clothing and apparel goods. The Examining Attorney’s own research shows this to be the case. In the first office action, the Examining Attorney cited two existing registrations for similar goods, both containing the wording “ouch,” owned by different entities. Besides the two cited marks, Applicant notes the existence of at least six other federal registrations or allowed applications for marks containing the words “ouch” for clothing or apparel goods. A chart reproducing this information is provided below, and printouts taken from search records of the United States Patent and Trademark Office electronic database were attached to Applicant’s July 16, 2008, Response to Office Action as required by TMEP 1207.01(d)(iii).

| mark | reg./app. no. | owner | goods/services |
|----------------------|--|----------------------|---|
| OUCH POUCH | 2,597,196 | Bunheads, Inc. | International class 025: Footwear, namely, elastic fabric and polymer gel products designed to protect areas of a dancer’s foot |
| OUCH POUCH, JR. | 2,597,192 | Bunheads, Inc. | International class 025: Footwear, namely, elastic fabric and polymer gel products designed to protect areas of a dancer’s foot |
| OUCHOHOL | 77/051163 | Paul Sarazen | International Class 025: T-shirts, hats, and jackets |
| OUCH | 78/433007 | Full90 Sports, Inc. | International Class 009: headgear for soccer, namely sports helmets |
| OUCHLESS | 2,855,927 | Goody Products, Inc. | International Class 026: Hair accessories, namely, elastic hair bands and ponytail holders |
| OUCH SWEAT AND TEARS | 78/327,352 (abandoned after notice of allowance over cited ‘347 reg.) | Zoran Aleksich | International Class 025: Sportwear, namely, t-shirts, sweat shirts, sweat pants, sport hats, caps, head wear, ski caps, sport shoes, tennis shoes, soccer shoes, jackets, wind jackets, warm jackets, ski jackets ... |

These multiple third party registrations of marks containing the phrase “ouch” for related goods are highly probative in this case to show that otherwise distinguishable marks containing this terminology can co-exist in the marketplace without a likelihood of confusion as to the source of the goods. It is quite clear that the field of “ouch” marks is a crowded one. The “crowded field” doctrine is a very relevant factor in the likelihood of confusion analysis in the present case. “In such a crowd, customers will not likely be confused between any two of the crowd ... Thus, in a ‘crowded’ field of similar marks, each member of the crowd is relatively ‘weak’ in its ability to prevent use by others in the crowd.” 1 J.T. McCarthy, Trademarks and Unfair Competition § 11:26 at 510-11 (4th ed. 1996); *accord* K-H-S Plastics, Inc. v. Carolite, Inc., 161 USPQ 75, 78 (9th Cir.).

Including the '347 and '697 registrations, at least eight marks containing the word “ouch” owned by different owners have been registered or allowed for various types of clothing or apparel items. As members of a crowded field, marks containing the terminology “ouch” for such goods are less protected. It is evident that the Trademark Office has recognized that consumers can differentiate between different sources of clothing and apparel goods offered under otherwise distinguishable marks that share in common the phrase “ouch.”

Considering the weakness of the terminology “ouch” in marks used for clothing and apparel goods and the differences between the marks as a whole, Applicant's mark should be registerable along with the many other dissimilar marks containing the same “ouch” terminology.

B. Applicant's Mark is Sufficiently Different from the Cited Marks as to Avoid a Likelihood of Confusion.

Applicant's mark is a composite containing, together with the word "ouch," a dominant design featuring the profile of a mountain with a backpacker hiking up the mountain, the word elements "!" and "Mountain," and a unique lettering font where the "Mountain" element is in cursive with the "t" integrated into a tree design and the "ouch!" element is in broken font indicating that the backpacker going up the mountain may be "broken" before he reaches the top. These features are all intended to provide a wilderness or backpacking impression and that the goods sold under the mark are hearty and meant to be used in outdoors activities. The "ouch" term followed by an exclamation mark further enhances the impression that the goods sold under Applicant's mark are intended for outdoorsmen who will be exerting significant effort in outdoor activities, such as backpacking up a mountain. These numerous unique features of Applicant's mark creates a distinct commercial impression unlike anything in the cited marks. Given the weakness of the common terminology "ouch," the presence of the dominant design element and the other unique elements in Applicant's mark makes the absence of any reasonable likelihood of confusion with the cited marks even more obvious.

In contrast to the two very similar marks of the '347 and '647 registrations, which are much more similar to each other than to Applicant's mark, Applicant's mark is distinctly different. All of the features of Applicant's mark are designed to show that Applicant's goods are directed towards serious outdoorsmen and to provide an "outdoorsy" feel. In fact, Applicant's description of goods has been amended to explicitly state that Applicant's mark is for use with clothing and apparel for outdoorsmen. Nothing in the cited mark would provide a consumer with any outdoors impression.

The mark OUCH WEAR SO GOOD IT HURTS for clothing is used in a tongue in cheek manner to indicate that the clothing sold under the mark has a good quality or will make the wearer look good and to grab attention. The mark provide a commercial impression completely different than the commercial impression provided by Applicant's mark. No reasonable consumer would associate the goods sold under the cited mark to come from the same source of outdoor/backpacking clothing or apparel sold under Applicant's mark with a mountain design with a backpacker hiking up the mountain, "mountain" terminology, unique lettering style featuring a tree in place of the "t" in "mountain" and broken font in the "ouch!" term. The Examining Attorney has incorrectly focused on a single weak portion of Applicant's mark which is common to the cited marks and many others, all for very similar goods. Applicant's mark is more than sufficiently distinctive to differentiate Applicant's goods from the goods sold under the cited marks.

As an example of a similar case, we submit the case of In re Electrolyte Laboratories, Inc., 929 F.2d 645, 16 USPQ2d 1239 (Fed. Cir. 1990). In that case, the Court of Appeals for the Federal Circuit found that the Trademark Trial and Appeal Board erred by holding that applicant Electrolyte's K+ (stylized) trademark was likely to cause confusion with the registrant's mark, K+EFF. Both marks were used for potassium dietary supplements. The Federal Circuit found that the TTAB was in error for focusing only on the "K+" portion of the marks, to the exclusion of the other elements.

In concluding that the TTAB erred in its focus on a common word portion of both marks to the substantial exclusion of the design elements and other dissimilar word elements of the marks, the Court observed that "'Electrolytes' [applicant's] mark is a composite of which the design is a significant feature thereof. The EFF in the registrant's mark is also significant ... [the

marks] are not identical and the design of the marks is substantially different. We conclude that Electrolyte's mark, viewed as a whole, serves to distinguish its goods from those of others." Id. at 1240. It is also noteworthy that, as in the present case, the common "K+" element was weak, being the chemical symbol for the element potassium used in the products sold under the marks.

The prominent design element, "!" and "Mountain" elements, and the stylized lettering in Applicant's mark creates a profoundly greater distinguishing factor between Applicant's mark and the cited mark than the minimal design element found to be sufficient in the Electrolyte case. Applicant's mark is dominated by its strong, distinctive design element. The "ouch" word portion of Applicant's mark is much smaller than the design element and appears in upper-left hand corner of the mark. In contrast, the '347 mark is a word mark in stylized font. There is nothing like the prominent design element or any indication of an "outdoorsy" connotation in either of the cited marks and nothing that would cause any likely confusion to a consumer.

Further, if the mark OUCH for swimwear can co-exist with the mark OUCH WEAR SO GOOD ITS HURTS in stylized font without a significant design for t-shirts, jackets, and hats without creating a likelihood of confusion as to source, then surely a composite mark containing the weak term "ouch" with a dominant design and additional word elements in a distinctive lettering font can co-exist as well without giving rise to a likelihood of confusion. The Examining Attorney has improperly focused on the weak, common terms of the marks when the Applicant's mark, considered in its entirety, is readily distinguishable from the cited marks.

Finally, it must be remembered that under the likelihood of confusion test, there must be a "probability" of source confusion as opposed to a mere possibility of source confusion. See, Sure-Fit Products Co. v. Saltzson Drapery Co., 117 USPQ 295 (CCPA 1958). In this case, as discussed above, considering (1) the weakness of the common element "ouch" in Applicant's

mark and the cited marks, (2) the fact that separately owned registrations for marks containing the term “ouch” already co-exist for similar goods, and (3) Applicant’s composite mark consisting of a distinctive “mountain” design element, the terms “mountain” and the “!” element in a distinctive lettering style, Applicant submits that confusion as to source is not sufficiently probable to reasonably support the refusal under Section 2(d).

Conclusion

For at least the reasons stated herein, the refusal to register Applicant’s mark under Section 2(d) of the Trademark Act is not well taken and should be reversed. A prompt ruling to this effect by this Honorable Board is respectfully requested.

Respectfully submitted,

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